

REMARKS

Claims 7-25 are pending. Claims 1-6 have been withdrawn. Claims 7, 12, and 14 have been amended. New claims 21-25 have been added.

I. Election/Restriction

In response to the telephone inquiry by the Examiner on March 2, 2004, Applicant elected, with traverse, Group II, claims 7-20. Applicant affirms the election made.

II. Rejections under 35 U.S.C. § 112

Claim 12 has been amended to address the antecedent basis error cited by the Examiner.

III. Rejections under 35 U.S.C. § 103

1. References fail to teach or suggest all claim limitations

Claims 7-20 stand rejected under 35 U.S.C. § 103 over various combinations of U.S. Patent No. 5,691,541 to Ceglio et al. ("Ceglio"), U.S. Patent No. 6,133,986 to Johnson et al. ("Johnson"), U.S. Patent No. 5,448,689 to Matsuo et al. ("Matsuo"), U.S. Patent No. 5,200,925 to Morooka ("Morooka"), and U.S. Patent No. 5,907,329 to Nobutani et al. ("Nobutani"). As the PTO recognizes in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added). Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." Applicant respectfully submits that the various combinations of references fail to teach or suggest each element of the claims as required by MPEP § 2143.

Claims 7-13

Claim 7, as amended, recites in part "a processing device connectable to the first memory, the processing device operable to calculate an angle of rotation between a pixel panel and a subject based on a value K, wherein the value K defines a number of points of the pixel panel that fall onto a single scan line on the subject, and to manipulate the image data based on the angle of rotation."

Applicant can find no teaching or suggestion in the cited references of calculating an angle of rotation based on a value K that defines a number of points of a pixel panel that fall onto a single scan line on a subject. Accordingly, the cited art fails to teach or suggest all the claim limitations as required by MPEP § 2143, and claim 7 is allowable over the cited references. Claims 8-13 depend from and further limit claim 7 and are allowable for at least that reason.

Claims 14-20

Claim 14, as amended, recites in part: "calculating an angle of rotation between a pixel panel and the subject based on a value K, wherein the value K defines a number of points of the pixel panel that fall onto a single scan line."

Applicant can find no teaching or suggestion in the cited references of calculating an angle of rotation based on a value K that defines a number of points of a pixel panel that fall onto a single scan line on a subject. Accordingly, the cited art fails to teach or suggest all the claim limitations as required by MPEP § 2143, and claim 14 is allowable over the cited references. Claims 15-20 depend from and further limit claim 14 and are allowable for at least that reason.

2. Combination of references is improper

Applicant respectfully submits that the various combinations of references, including the combination of Ceglio and Johnson, are improper. MPEP § 2142 that "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'."

Here, none of the references, alone or in combination, teaches or even suggests the desirability of the combinations used to reject claims 7 and 14 since the references fail to

disclose a value K, wherein the value K defines a number of points of the pixel panel that fall onto a single scan line on the subject, as is recited by both claims 7 and 14. Thus, it is clear that none of the references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support the 35 U.S.C. § 103(a) rejections.

In this context, the MPEP further provides at § 2143.01: "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.

In the present case it is clear that the combination of the cited references arises solely from hindsight without any showing, suggestion, incentive, or motivation in any of the references for the combinations as applied to claims 7 and 14. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a prima facie case of obviousness can clearly cannot be met, and the rejections under 35 U.S.C. § 103(a) should be withdrawn.

3. New claims 21-25

New claim 21 recites a method for transferring image data in real time for projection by a pixel panel, the method comprising: extracting a predefined amount of image data from a memory using a digital signal processor; calculating an angle of rotation between the pixel panel and a subject based on a value K, wherein the value K defines a number of points of the pixel panel that fall onto a single scan line; calculating a location for each of a plurality of image portions of the extracted image data on the pixel panel, wherein each location accounts for the angle of rotation; loading each bit from each of the image portions into a corresponding one of a plurality of registers of a shift register, wherein the loading orders the bits based on the location calculated for each image portion; transferring each of the image portions into a frame buffer; and transferring each frame to the pixel panel, wherein the extracting, calculating, loading, and transferring occurs in real time in response to a demand for image data for the pixel panel.

Applicant can find no teaching or suggestion in the cited references of each element of claim 21. Accordingly, the cited art fails to teach or suggest all the claim limitations as required by MPEP § 2143, and claim 21 is allowable over the cited references. Claims 22-25 depend

from and further limit claim 21 and are allowable for at least that reason. Moreover, the Applicant can find no teaching or suggestion of the subject matter of claims 22-25 in the cited references. Accordingly, claims 22-25 are also deemed to be in condition for allowance.

IV. Conclusion

It is respectfully submitted that all the claims in the application are in condition for allowance. Should the Examiner deem that any further amendment is needed to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

T. F. Bliss

Timothy F. Bliss
Registration No. 50,925

Dated: June 24, 2004
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 972-739-8638
Facsimile: 214-200-0853
File: 22397.290
R74788-1

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 24, 2004.

Gayle Conner
Gayle Conner